

Notice of Allowability

Application No.

10/030,763

Examiner

Thomas M. Ho

Applicant(s)

ADAM ET AL.

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 7/12/02.
2. ☒ The allowed claim(s) is/are 1-49.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

1. Claims 1-49 are pending.

Reasons for Allowance

In reference to claim 1:

Jacobs, PCT WO 98/34203, published August 6th, 1998, "Method and Apparatus for performing financial transactions using a mobile communication unit" discloses a transaction system for conducting financial transactions, cooperating with a mobile telephony network adapted to provide telephony services to a plurality of mobile phones, said system comprising:

- An administrating server adapted to administer accounts of merchants and customers, and adapted to communicate at a given time with at least one of the plurality of mobile phones of a customer via the mobile telephony network, where the administrating server is the financial clearing house, where the merchant is the merchant, and the customer is the operator of the mobile device. (page 6, last paragraph)
- At least one of a plurality of communication units which are located at merchant's point of sale adapted to communicate with said administrating server, where the merchant is capable of communicating with the financial clearinghouse. (page 6, last paragraph) & (Figure 5)
- Wherein the communication unit is adapted to identify the mobile phone, and adapted to communicate to said administrating server a first communication message comprising

transaction details, identifying the merchant, the customer, and specifying an amount to be paid, where the communication unit identifies the customer who is the operator of the mobile making a purchase or transaction, and where the transaction details are forwarded to a financial clearinghouse. (page 7, 2nd paragraph)

- Wherein said administrating server is adapted to communicate the transaction details in a second communication message via the mobile telephony network to the mobile phone for authorization by the customer, and adapted to receive authorization from the customer in a third communication message from the mobile phone via the mobile telephony network, where the administrating server is the financial clearing house which receives authorization from the customer mobile. (page 8, 1st paragraph)
- Wherein said administrating unit is further adapted to communicate a transaction authorization in a fourth communication message to said communication unit, where the fourth communication message is the forwarding of the customer verification to the merchant unit from clearinghouse (page 8, 2nd paragraph, referred to in the paragraph as “Figure 2, Steps 126 and 128) & (Figure 5)
- And wherein said administrating server is adapted, after receiving the finalizing message to debit the customer’s account in the amount to be paid and credit the merchant’s account accordingly, where the account is debited. (page 8, 2nd paragraph – page 9, 1st paragraph)

Jacobs fails to disclose:

Art Unit: 2134

- Wherein said communication unit is adapted to finalize the transaction by communicating a fifth communication message to said administrating server;

Jacobs fails to disclose:

- Wherein said communication unit is adapted to finalize the transaction by communicating a fifth communication message to said administrating server;

No art has been found which recites this limitation. A search of the prior art has uncovered that in a typical transaction method, neither a fourth communication message or a fifth communication message in accordance with the claim is sent. The fourth and fifth messages within claim 1 convey a transaction authorization message to the financial transaction clearinghouse, or a third party authority to the merchant after an initial transaction between the merchant and client has been initiated. In the system common in the art, a transaction between a mobile client and a customer is initiated when the client desires to purchase a good or service from a merchant. An additional authorization request is returned to the client to finalize the transaction. While in some instances, the *identity* of a merchant, or "a communication unit" may be validated (such as in SET or SSL/TLS protocols), an embodiment requesting further authorization *from* the merchant is a step that a search of the prior art has not uncovered. Indeed, such a step would appear extraneous to one of ordinary skill in the art, providing an additional computational burden that would be unnecessary for most transactions.

Art Unit: 2134

No motivation to combine to read upon the recitation has been found. If indeed a merchant is to verify a particular transaction, the common enablement in the art is to verify such a transaction with the client rather than have a third party request additional authorization from the merchant, after the client has already authorized the sale. Additionally, it is noted that the Applicant has worded the limitation in the claim to recite "a *fifth* communication message to said administrating server" implying that even if such a limitation could be found, it would be necessary to have a step in addition to the other four communication messages of the claims. In other words, a secondary authorization by the merchant point of sale communication device would be necessary. A search of the prior art has not uncovered this limitation nor a motivation to modify the current reference as such. Accordingly, no rejection has been given and the claims are allowable.

In reference to claim 24:

Jacobs, PCT WO 98/34203, published August 6th, 1998, "Method and Apparatus for performing financial transactions using a mobile communication unit" discloses a transaction system for conducting financial transactions, cooperating with a first mobile telephony network adapted to provide telephony services to a plurality of mobile phones and at least one of a plurality of mobile phones of visitors originally registered with a second mobile telephony network, said system comprising:

- A first administrating server adapted to administer accounts of merchants and customers, and adapted to communicate at a given time with at least one of the plurality of mobile phones of a customer via the mobile telephony network, where the administrating server is the financial clearing house, where the merchant is the merchant, and the customer is the operator of the mobile device. (page 6, last paragraph)
- A second administrating server similar to the first administrating server operating in the second mobile telephony network, administrating accounts of the visitors and adapted to communicate with said first administrating server, where the second administrating server is the credit card companies which administrate the accounts of the visitors who are the users of the mobile device (Page 8, 2nd paragraph)
- At least one of a plurality of communication units which are located at merchants' point of sale adapted to communicate with said first administrating server, where the merchant is capable of communicating with the financial clearinghouse. (page 6, last paragraph) & (Figure 5)
- Wherein the communication unit is adapted to identify the visitor's mobile phone, and adapted to communicate to said first administering server a first communication message comprising transaction details, identifying the merchant, the visitor and specifying an amount to be paid, where the communication unit identifies the customer who is the operator of the mobile making a purchase or transaction, and where the transaction details are forwarded to a financial clearinghouse. (page 7, 2nd paragraph)
- Wherein said first administrating server is adapted to verify the visitors identification details and balance with the second administrating server, to communicate the transaction

details in a second communication message via the mobile telephony network to the visitor's mobile phone for authorization by the visitor, and adapted to receive authorization from the visitor in a third communication message from the mobile phone via the mobile telephony network where the second administrating server is the credit card companies used in payment (page 7, paragraph 3) & (Page 8, 2nd paragraph) , and where the administrating server is the financial clearing house which receives authorization from the customer mobile. (page 8, 1st paragraph)

- wherein said first administrating unit is further adapted to communicate a transaction authorization in a fourth communication message to said communication unit, where the fourth communication message is the forwarding of the customer verification to the merchant unit from clearinghouse (page 8, 2nd paragraph, referred to in the paragraph as "Figure 2, Steps 126 and 128) & (Figure 5)
- And wherein said first administrating server is adapted, after receiving the finalizing message to communicate with said second administrating server and facilitate debiting the visitor's account in the amount to be paid and credit the merchant's account accordingly, where the account is debited. (page 8, 2nd paragraph – page 9, 1st paragraph)

Jacobs fails to disclose:

- Wherein said communication unit is adapted to finalize the transaction by communicating a fifth communication message to said administrating server;

No art has been found which recites this limitation. A search of the prior art has uncovered that in a typical transaction method, neither a fourth communication message or a fifth communication message in accordance with the claim is sent. The fourth and fifth messages within claim 1 convey a transaction authorization message to the financial transaction clearinghouse, or a third party authority to the merchant after an initial transaction between the merchant and client has been initiated. In the system common in the art, a transaction between a mobile client and a customer is initiated when the client desires to purchase a good or service from a merchant. An additional authorization request is returned to the client to finalize the transaction. While in some instances, the *identity* of a merchant, or "a communication unit" may be validated (such as in SET or SSL/TLS protocols), an embodiment requesting further authorization *from* the merchant is a step that a search of the prior art has not uncovered. Indeed, such a step would appear extraneous to one of ordinary skill in the art, providing an additional computational burden that would be unnecessary for most transactions.

No motivation to combine to read upon the recitation has been found. If indeed a merchant is to verify a particular transaction, the common enablement in the art is to verify such a transaction with the client rather than have a third party request additional authorization from the merchant, after the client has already authorized the sale. Additionally, it is noted that the Applicant has worded the limitation in the claim to recite "a *fifth* communication message to said administering server" implying that even if such a limitation could be found, it would be necessary to have a step in addition to the other four communication messages of the claims. In

Art Unit: 2134

other words, a secondary authorization by the merchant point of sale communication device would be necessary. A search of the prior art has not uncovered this limitation nor a motivation to modify the current reference as such. Accordingly, no rejection has been given and the claims are allowable.

Independent Claim 27 is substantially similar to claim 1 and is allowable for the same reasons.

Independent claim 45 is substantially similar to claim 24 and is allowable for the same reasons.

All other claims are dependent on independent claims 1, 24, 27, or 45, and are allowable because their independent claims are allowable.

Claim 24 recites some minor informalities however that the Applicant is invited to correct.

The fifth limitation of claim 24 recites: "wherein said first administrating server is adapted verify the visitors identification details and balance wioth..." The applicant is invited to change at least, the misspelling of "with", the addition of "to" between "adapted" and "verify", and the addition of an apostrophe to "visitors".

Conclusion

2. The following art considered but not relied upon is made of record:

- US patent 5608778 discloses a cellular telephone as transaction controller
- US patent 5991410 discloses a wireless adaptor and financial transaction system
- EU patent application EP 0848360 A1 discloses an electronic funds transfer authentication system
- US patent 6990586 discloses a secure data transmission transaction controller.
- US patent 5914472 discloses a credit card authorization spending system with a message relayed back to another party close to the client.
- US patent 5825883 discloses a method of debiting an account with a digital application
- US patent 5796790 discloses a method of electronic billing
- US patent 5796832 discloses a wireless financial transaction system
- EU patent application EP 0780802 A2 discloses a wireless billing system

3. Any inquiry concerning this communication from the examiner should be directed to Thomas M Ho whose telephone number is (571)272-3835. The examiner can normally be reached on M-F from 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (571)272-3838.

The Examiner may also be reached through email through Thomas.Ho6@uspto.gov

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2100.

Application/Control Number: 10/030,763

Page 11

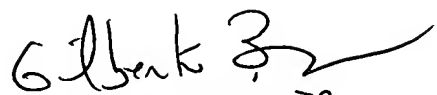
Art Unit: 2134

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TMH



June 25th, 2006



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